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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/535,314 03/24/00 BRIDGER

G 391442003700

EXAMINER

HM12/0813

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BALASUBRAMANIAN, V	
ART UNIT	PAPER NUMBER

1624  
DATE MAILED:

08/13/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
09/535,314

Applicant(s)  
Bridger et al.

Examiner  
Venkataraman Balasubramanian

Art Unit  
1624



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Jun 4, 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6, 7, 12, 13, 51, 55-58, and 97-102 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-4, 6, 7, 12, 13, 51, 55-58, and 97-102 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 20) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Applicants' response to Restriction Requirement filed on 6/4/2001, is made of record. Election of group II, claims 1-4, 6-7, 12-13, 51, 55-58 and 97-102 drawn to compound of formula I wherein P in the X variants is nitrogen, in paper # 10 is acknowledged. In addition, applicants' amendment to claims 1-2, 6 and cancellation of claims 91-96, 103-106, 108-114 and 117-118 is also acknowledged.

Claims 1-4, 6-7, 12-13, 51, 55-58 and 97-102 are now pending.

However, upon further consideration, in view of the fact that applicants are permitting A ring to have heteroatoms which in principle negates the reason for the restriction requirement of paper #8, the following revised restriction requirement is made.

#### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-4, 6-7, 12-13, 51, 55-58, 97-102, drawn to compound & composition of formula I wherein PA ring in the X variants is non-fused six-membered ring and has only one nitrogen and no other hetero atoms, classified in class 546 sub classes 152, 346, class 514, subclass 352 and other classes and subclasses depending upon the preferred embodiments of Ar-hetero ring substituents.
- II. Claims 1-4, 6-7, 12-13, 51, 55-58, 97-102, drawn to compound & composition of formula I wherein PA ring in the X variants is non-fused six-membered ring and has only two nitrogens and no other hetero atoms, classified in class 544, subclasses various, class 514, subclasses various and other classes and

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subclasses depending upon the preferred embodiments of Ar-hetero ring substituents.

- III. Claims 1-4, 6-7, 12-13, 51, 55-58, 97-102, drawn to compound & composition of formula I wherein PA ring in the X variants is non-fused six-membered ring and has only three nitrogens and no other hetero atoms, classified in class 544, subclasses 180,182 , class 514 , subclasses 241, 242 and other classes and subclasses depending upon the preferred embodiments of Ar-hetero ring substituents.
- IV. Claims 1-4, 6-7, 12-13, 51, 55-58, 97-102, drawn to compound & composition of formula I wherein PA ring in the X variants is non-fused six-membered ring not provided for in group I-III, classified in classes various, subclasses various, class 514, subclasses various and other classes and subclasses depending upon the preferred embodiments of Ar-hetero ring substituents.
- V. Claims 1-4, 6-7, 12-13, 51, 55-58, 97-102, drawn to compound & composition of formula I wherein PA ring in the X variants is non-fused five-membered ring and has only one nitrogen and no other hetero atoms, classified in class 548, subclasses 557 etc., class 514, subclass 408, and other classes and subclasses depending upon the preferred embodiments of Ar-hetero ring substituents.
- VI. Claims 1-4, 6-7, 12-13, 51, 55-58, 97-102, drawn to compound & composition of formula I wherein PA ring in the X variants is non-fused five-membered ring and has only two nitrogens and no other hetero atoms, classified in class 548, subclasses 326.5, 371.4 etc., class 514, subclasses 385, 403, and other classes

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and subclasses depending upon the preferred embodiments of Ar-hetero ring substituents.

- VII. Claims 1-4, 6-7, 12-13, 51, 55-58, 97-102, drawn to compound & composition of formula I wherein PA ring in the X variants is non-fused five-membered ring and has only three nitrogens and no other hetero atoms, classified in class 548, subclasses 255, 262.2 etc, class 514, subclasses 359, 384, and other classes and subclasses depending upon the preferred embodiments of Ar-hetero ring substituents.
- VIII. Claims 1-4, 6-7, 12-13, 51, 55-58, 97-102, drawn to compound & composition of formula I wherein PA ring in the X variants is non-fused five-membered ring not provided for in group V-VII, classified in classes various, subclasses various, class 514, subclasses various and other classes and subclasses depending upon the preferred embodiments of Ar-hetero ring substituents.
- IX. Claims 1-4, 6-7, 12-13, 51, 55-58, 97-102, drawn to compound & composition of formula I wherein the X variants is PA-B ring i.e. fused five or six-membered ring with 5 to 7-membered ring, classified in classes various, subclasses various, depending upon the preferred embodiments of PA-B ring and Ar-hetero ring substituents.

If applicants elect a group from the groups I-III and V-VII, applicants should elect a species from that group for examination.

If group IV is elected applicant should elect specific heteroatoms in the X variant group, i.e. PA along with a species in that group for examination.

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If group VIII is elected applicant should elect specific heteroatoms in the X variant group, i.e. PA along with a species in that group for examination.

If group IX is elected, applicants should elect specific heteroatoms in PA-B ring system including the ring size for both ring in PA-B along with a species in that group for examination.

The inventions are distinct, each from the other because of the following reasons:

Inventions I through VI are independent and distinct from each other because they are directed to structurally dissimilar compounds that lack common core namely pyridine vs pyridazine vs pyrimidine vs pyrazine vs piperazine vs triazine vs quinoline vs pyran or benzopyran vs thiane or benzofused thiane, pyrazole vs pyridazole vs imidazole and their fused analogs vs benzenoid etc . Consequently, the groups have different classifications and require separate prior art searches. Search of these class of compounds with variant permitted would pose a serious burden. They can be made and used independently. Art which may render obvious or anticipate one of the groups would not necessarily do the same for the other group. For example, prior art cited in the Information Disclosure Statement which reads on benzimidazole compounds may not be applicable for other heterocycles embraced herein. Each can support a patent as the compounds of each group are capable of being utilized alone not in combination with other members listed in the Markush group.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

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This application contains claims directed to the following patentably distinct species of the claimed invention: See claims 97-101.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-4,6-7,12-13, 51 , 55-58 and 102 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

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Due to the distinct nature of the inventions a restriction is set forth in writing.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication from the examiner should be addressed to Venkataraman Balasubramanian (Bala) whose telephone number is (703) 305-1674. The examiner can normally be reached on Monday through Thursday from 8.00 AM to 5.00 PM.

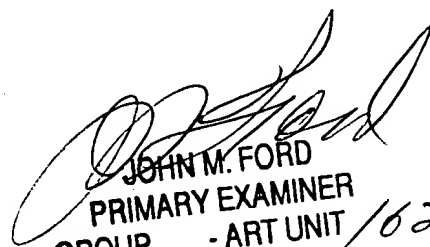
The fax phone number for the organization where this application or proceeding is assigned (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

VB

V. Balasubramanian (Bala)

8/9/2001

  
JOHN M. FORD  
PRIMARY EXAMINER  
GROUP - ART UNIT 1624